

### REMARKS

Claims 1-14, 16, 17, 19-27, 29-36, 38-46 and 48 are pending in the present application. Reconsideration of the claims is respectfully requested.

#### **I. 35 U.S.C. § 103, Obviousness**

The Examiner rejected Claims 1-14, 16, 17, 19-27, 29-36, 38-46 and 48 under 35 U.S.C. § 103 as being unpatentable over Shkedy (U.S. Pat. No. 6,260, 024) in view of Hoyt et al. (U.S. Pat. No. 6,067,531). This rejection is respectfully traversed.

In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. *Id.*

To establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. MPEP 2143.03. *See also, In re Royka*, 490 F.2d 580 (C.C.P.A. 1974) (emphasis added by Applicants). If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Applicants will now show that the Examiner has failed to establish a prima facie showing of obviousness, and thus the burden has not shifted to Applicants to rebut an obviousness assertion. In addition, as a prima facie case of obviousness has not been made, the rejection is shown to be improper, per *In re Fine*, *Id.*

A(1). With respect to Claim 1 (and dependent Claims 2-6), Applicants show that none of the cited references teach or suggest the claimed feature of "storing at least one terms and conditions set containing parameters corresponding to selected rules from the compilation of business rules". In rejecting Claim 1, the Examiner alleges that the cited Shkedy reference teaches "storing set containing parameters (see., abstract, figs 2 and 3, col. 2, lines 1-9, col. 5, lines 32-67)". The Examiner acknowledges that the cited Shkedy reference fails to explicitly disclose a compilation of business rules or storing terms and conditions. The Examiner then goes on to state that the cited Hoyt reference teaches a

client applet that enforces business rules to qualify a contract for expedited approval. This business rule enforcement assertion does not establish a teaching or suggestion by Hoyt of a terms and conditions set containing parameters corresponding to selected rules from the compilation of business rules". This claimed feature advantageously provides an ability for logic associated with the business rules to use execution parameters. For example, if the business rules contain logic to determine a discounted price, the corresponding terms and conditions instance in the terms and conditions set would set the discount percentage (Specification page 16, lines 4-7). Claim 1 is thus shown to have been erroneously rejected as there is at least one missing claimed element not taught or suggested by the cited references.

A(2). Further with respect to Claim 1 (and dependent Claims 2-6), Applicants show that none of the cited references teach or suggest the claimed feature of generating links between (1) the compilation of business rules and (2) the terms and conditions set to generate specific terms and conditions to be embodied in the contract. This claimed link generating step allows for generation of specific terms and conditions using the business rules, thus advantageously providing a hierarchical relationship where business rules for an entire business can be defined/described in the business rules, which can then be customized to generate specific terms and conditions for a contract (Specification page 16, lines 8-11; FIG. 3).

In rejecting this claimed step, the Examiner cites Shkedy Col. 5, lines 7-60 and Shkedy FIG. 5 as teaching "generating links between the contract". Applicants show that Claim 1 does not merely recited generating links between the contract, but rather recites that these generated links are between (i) the compilation of business rules, and (ii) the terms and conditions set. Thus, the links are between multiple recited items – the business rules and the terms/conditions set. **A mere assertion of links between a contract does not establish links between business rules and a terms and conditions set.** Thus, the Examiner has failed to establish a prima facie showing of obviousness with respect to Claim 1, per *In re Oetiker*, supra. Since a prima facie case of obviousness has not been made, the rejection of Claim 1 is improper, per *In re Fine*, supra. Claim 1 is

thus further shown to have been erroneously rejected as there is at least one additional missing claimed element not taught or suggested by the cited references.

**A(3).** Further with respect to Claim 1, there is no teaching or suggestion of the claimed step of "interlocking the compilation of business rules, the terms and conditions set and the links to lock the contract". In rejecting this step of Claim 1, the Examiner merely alleges that the cited Shkedy reference teaches "interlocking the links to lock the contract (sec., col 7, lines 26-42)". Applicants show multiple errors in such assertion with respect to Claim 1, as follows.

First, as shown above, the cited reference does not teach or suggest the claimed "links" between the business rules and terms and conditions, so it therefore cannot teach or suggest an interlocking step which uses such (non-existent) links. Secondly, a mere assertion of a teaching of "interlocking the links to lock the contract" does not establish a teaching or suggestion of interlocking (i) the compilation of business rules, (ii) the terms and conditions set *and* (iii) the links to lock the contract, as explicitly recited in Claim 1. Thus, the Examiner is further shown to have failed to establish a prima facie showing of obviousness with respect to Claim 1, as there are missing claimed features not alleged to be taught or suggested by the cited references. Therefore, Claim 1 is still further shown to have been erroneously rejected by the Examiner as there are still further missing claimed elements not taught or suggested by the cited references.

**B.** Further with respect to Claim 2 (and dependent Claims 3-5), Applicants show that none of the cited references teach or suggest, nor has the Examiner alleged any teaching or suggestion of, the claimed feature of "the computer further stores at least one product list filter for generating a list of a specified subset of products from a master list of products, and generates links between the product list filter, the terms and conditions set and the master list of products". Thus, the Examiner has failed to establish a prima facie showing of obviousness with respect to Claim 2 (and dependent Claims 3-5), the burden has not shifted to Applicants to rebut an obviousness assertion, and the rejection of Claim 2 (and dependent Claims 3-5) is thus improper as a prima facie case of obviousness has not been made.

C. Further with respect to Claim 3, Applicants show that none of the cited references teach or suggest, nor has the Examiner alleged any teaching or suggestion of, the claimed feature of "the product list filter comprises a plurality of tiers, each tier generating a list of a different subset of products". Thus, the Examiner has failed to establish a prima facie showing of obviousness with respect to Claim 3, the burden has not shifted to Applicants to rebut an obviousness assertion, and the rejection of Claim 3 is thus improper as a prima facie case of obviousness has not been made.

D. Further with respect to Claim 6, Applicants show that none of the cited references teach or suggest the claimed feature of "the contract is locked by the implementation of digital signatures". In rejecting Claim 6, the Examiner states that this feature is disclosed by Shkedy figs 2, 12 and 14, specifically signature keys, col 47-67. Applicants first show that the cited reference does not have cols 47-67 (the patent ends at col. 32). This discrepancy previously was pointed by Applicants in their previous Response to Office Action filed on June 2, 2004, yet the Examiner continues to maintain this erroneous citation to the reference in the present claim rejection.

As to the assertion with respect to Shkedy Figs 2, 12 and 14, while figure 14 does show use of a key, the key is not used to lock a contract, as claimed. Rather, this Shkedy key is used in conjunction with cryptographic techniques to authenticate the seller's bid (Shkedy Col. 22, lines 47-60). A teaching of bid authentication does not teach or suggest locking of a contract, as authentication does not provide any type of locking. Thus, Claim 6 is further shown to have been erroneously rejected as there is a missing claimed feature not taught or suggested by the cited references.

E. Applicants traverse the rejection of Claim 7 (and dependent Claims 8-13) for similar reasons to those given above regarding Claim 1.

Applicants further traverse the rejection of Claim 8 for further reasons given above regarding Claim 2.

Applicants further traverse the rejection of Claim 9 for further reasons given above regarding Claim 3.

Applicants further traverse the rejection of Claim 12 for further reasons given above regarding Claim 6.

F. With respect to Claim 14 (and dependent Claim 16), Applicants show that none of the cited references teach or suggest, nor has the Examiner alleged any teaching or suggestion of, any type of post-contract processing. Specifically, there is no teaching or suggestion, or alleged teaching or suggestion, of "A system for *conducting a contractual activity* over a computer network *pursuant to a contract* between at least one seller and at least one buyer, the contract comprising a predefined set of terms and conditions". In addition, Applicants show that none of the cited references teach or suggest, nor has the Examiner alleged any teaching or suggestion of, the claimed features of "wherein the communications interface *displays selected information based on terms and conditions in the contract*", or a computer for "receiving the information and *referencing the terms and conditions of the contract to process the information*". Thus, the Examiner has failed to establish a prima facie showing of obviousness with respect to Claim 14 (and dependent Claim 16), the burden has not shifted to Applicants to rebut an obviousness assertion, and the rejection of Claim 14 (and dependent Claim 16) is thus improper as a prima facie case of obviousness has not been made.

G. Applicants traverse the rejection of Claim 17 (and dependent Claim 19) for similar reasons to those given above regarding Claim 14.

Applicants traverse the rejection of Claim 20 (and dependent Claims 21-26) for similar reasons to those given above regarding Claim 1.

Applicants further traverse the rejection of Claim 21 for further reasons given above regarding Claim 2.

Applicants further traverse the rejection of Claim 22 for further reasons given above regarding Claim 3.

Applicants further traverse the rejection of Claim 25 for further reasons given above regarding Claim 6.

Applicants traverse the rejection of Claim 27 (and dependent Claim 29) for similar reasons to those given above regarding Claim 14.

Applicants traverse the rejection of Claim 30 (and dependent Claims 31-35) for similar reasons to those given above regarding Claim 1.

Applicants further traverse the rejection of Claim 31 for further reasons given above regarding Claim 2.

Applicants further traverse the rejection of Claim 32 for further reasons given above regarding Claim 3.

Applicants further traverse the rejection of Claim 35 for further reasons given above regarding Claim 6.

Applicants traverse the rejection of Claim 36 (and dependent Claim 38) for similar reasons to those given above regarding Claim 14.

Applicants traverse the rejection of Claim 39 (and dependent Claims 40-45) for similar reasons to those given above regarding Claim 1.

Applicants further traverse the rejection of Claim 40 for further reasons given above regarding Claim 2.

Applicants further traverse the rejection of Claim 41 for further reasons given above regarding Claim 3.

Applicants further traverse the rejection of Claim 44 for further reasons given above regarding Claim 6.

Applicants traverse the rejection of Claim 46 (and dependent Claim 48) for similar reasons to those given above regarding Claim 14.

H. Therefore, the rejection of Claims 1-14, 16, 17, 19-27, 29-36, 38-46 and 48 under 35 U.S.C. § 103 has been overcome.

## II. Conclusion


It is respectfully urged that the Examiner has failed to establish any teaching or suggestion of numerous claimed features, including (1) a terms and conditions set containing parameters corresponding to selected rules; (2) generating links between business rules and the terms and conditions set; (3) interlocking the business rules, the terms and conditions set and the links to lock the contract; (4) a computer that stores a product list filter and generates links between the product list filter, the terms and

conditions set and the master list of products; (5) a product list filter that comprises a plurality of tiers, each tier generating a list of a different subset of products; (6) the contract is locked by implementation of digital signatures; and (7) a system for conducting a contractual activity over a computer network pursuant to a contract, wherein a communication interface displays selected information based on terms and conditions in the contract. Thus, the Examiner has failed to establish a prima facie showing of obviousness, and the burden has not shifted to Applicants to rebut an obviousness assertion. In addition, as a prima facie case of obviousness has not been made, the rejection is shown to be improper, per *In re Fine*, supra.

It is further respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: 10/27/04

Respectfully submitted,

  
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